



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,478	08/07/2006	Peter Weingartner	BPP 305	1955
23581	7590	11/10/2008		
KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204				
EXAMINER				
RODRIGUEZ, RUTH C				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
11/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,478

Applicant(s)

WEINGARTNER, PETER

Examiner

RUTH C. RODRIGUEZ

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 2-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The finality is withdrawn since the rejection does not address all the claims limitations. However, in regard to applicant's general allegations that the Examiner should have reasonably expected the previously added limitations to be claimed, this is not persuasive. Firstly, applicant has failed to explain why one should have reasonably expected these changes when they were never previously presented. Secondly, amending claims to avoid the prior art is no an action included within the "reasonably expected" exception. Note the examples given in MPEP 706.07(a) for what constitutes the types of situations falling under the "reasonably expected". Third, the rules no longer give applicants the right to amend as often as the examiner presents new references or new reasons for rejections. Fourth, the addition of selected disclosed subject matter so that the claim may now avoid a particular art rejection is not something that should have been "reasonably expected". Why should the examiner have "reasonably expected" that particular limitations to the exclusion of all other disclosed but not claimed limitations?

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinckney (US 2,797,886) in view of Froehlich (US 3,600,764).

Pinckney discloses a clip (1) clamping an object (25) at the object's corners or sides (Figs. 1-5). The clip comprises two limbs (18) and a pre-tensioned back (17) configured to apply a force to the limbs (Figs. 1-5). The clip is configured to be U-shaped with the limbs parallel to each other in a relaxed state (Figs. 1-5). Each limb includes a small inward fold (19) of less than 90 degrees (Figs. 1-5). Each inward fold defines a fold line (Figs. 1-3). The fold being disposed at the region of each limb furthest from the back (Figs. 1-5). The clip is configured so that the object may be clamped between the limbs by virtue of the compressive force applied by the pre-tensioned back (Figs. 1-3). The clip comprises metal or high-strength plastic or wood or compressed cellulose (Column 3, lines 28-32). Pinckney discloses that the object being held between the inward folds is a toothbrush. Pinckney fails to disclose that the object is sheets of paper, plastic, metal, and other materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the clip being capable of clamping a plurality of sheets of paper, plastic, metal or other materials

whose combined thickness is greater than the distance between the two folds

However, Froehlich also teaches a clip (10) clamps sheets of paper, plastic, metal, and other materials (22) at the sheet corners or sides (Figs. 1-3). The clip comprises two limbs (12,14) and a pre-tensioned back (16) configured to apply a force to the limbs. The clip is configured to be U-shaped in a relaxed state (Figs. 1-3). Each limb includes a small inward fold (18,20) of less than 90 degrees (Figs. 1-3). Each inward fold defines a fold line (Figs. 1-3). The fold is disposed at the region of each limb furthest from the back (Figs. 1-3). The clip is configured so that the sheets may be clamped between the limbs by virtue of the compressive force applied by the pre-tensioned back (Figs. 1-3). The clip comprises metal or high-strength plastic or wood or compressed cellulose (C. 1, L. 47-51). The folds have facing frictional surfaces (18',20') that are substantially parallel and embrace each other in the non-expanded condition of the clip so that the frictional strength of the folds prevents movement of the sheet object when the sheet object is placed between the two folds (C. 2, L. 29-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the folds having facing frictional surfaces that are substantially parallel and embrace each other in the non-expanded condition of the clip as taught by Froehlich in the clip of Pinckney. Doing so, provides frictional strength of the folds prevents movement of the sheet object when the sheet object is placed between the two folds.

The clip is characterized by the fact that sheets may be clamped between the limbs by virtue of the force applied by the pre-tensioned back (as taught by Froehlich) in

combination with projections (disclosed by Pinckney) incorporated into the limbs (Figs. 1-3).

The clip is characterized by the fact that each limb is rectangular. Pinckney and Froehlich fails to disclose that the clip is characterized by the fact that each limb is triangular, trapezoidal, semicircular or semielliptical. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the clip being characterized by the fact that each limb is triangular, trapezoidal, semicircular, or semielliptical since a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Especially since the clip will perform equally as well regardless whether the shape of each limb is rectangular, triangular, trapezoidal, semicircular or semielliptical.

4. Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinckney in view of Froehlich as applied to claim 4 above, and further in view of Burleigh et al. (US 2,310,835)

Pinckney discloses that both limbs are arranged on top of each other and parallel to each other in the relaxed state of the clip (Figs. 1-3). Pinckney and Froehlich fail to disclose that the both limbs are arranged on top of each other and parallel to each other in a state with a clamped stack of sheets by means of a spring. However, Burleigh teaches a clip comprises two limbs (4) and a pre-tensioned back (1) configured to apply a force to the limbs. The clip is configured to be U-shaped with the two limbs parallel to each other in a relaxed state (Fig. 1). Each limb includes a small fold (Figs. 1 and 2).

The clip is configured so that sheets can be clamped between the limbs by virtue of the force applied to the pre-tensioned back (Figs. 1 and 2). The clip comprises metal or high-strength plastic or wood or compressed cellulose (Figs. 1 and 2). The spring allows the limbs to be parallel to each other at all times while providing a firm grip in the sheets (Page 2, column 1, lines 13-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to both limbs are arranged on top of each other and parallel to each other in a state with a clamped stack of sheets by means of a spring as taught by Burleigh in the clip disclosed by Pinckney and modified by Froehlich. Doing so, allows the limbs to be parallel to each other at all times while providing a firm grip in the sheets. Burleigh also teaches that clip is made to be multipart with both limbs being connected by a spring (1). When the combination of Pinckney, Froehlich and Burleigh is taken into consideration the limbs will not have mutual contact because the folds of Shuey will prevent mutual contact between the limbs.

Burleigh also teaches that the clip is characterized by the fact that it is made to be multipart (1,4) with both limbs (4) being connected by means of a spring (Figs. 1 and 2) without making mutual contact when the combination of Pinckney, Froehlich and Burleigh is taken into consideration the limbs will not have mutual contact because the folds of Pinckney or Froehlich will prevent mutual contact between the limbs.

The clip taught by Burleigh is characterized by the fact that the clip is made to be multipart.

Allowable Subject Matter

5. Claim 8 is allowed.
6. The following is an examiner's statement of reasons for allowance:

Regarding claim 8, the combination of Pinckney and Froehlich used to reject claim 4 discloses most of the limitations of claim 8. Pinckney and Froehlich fail to disclose that the fold line is disposed at an acute angle with respect to the back. Accordingly, it would not have been obvious to one having ordinary skill in the art at the time the invention was made to have a clip having a U-shaped configuration with the limbs of the U-shaped configuration being parallel to each other and with each limb having a small inward fold of less than 90 degrees where each inward fold defines a fold line with the fold line being disposed at an acute angle with respect to the back and the clip is configured so that the object may be clamped between the limbs by virtue of the compressive force applied by the pre-tensioned back. Other prior art of record has a fold line being parallel to the back and there is no motivation to have the fold line being disposed at an acute angle with respect to the back.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

7. Applicant's arguments with respect to claims 2-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUTH C. RODRIGUEZ whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor D. Batson can be reached on (571) 272-6987.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3677

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/RCR/
Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

rcr

November 8, 2008

/Robert J. Sandy/
Primary Examiner, Art Unit 3677